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IN THE

Supreme Court of the United States

OCTOBER TERM, 1975

No. 75-1009

DUNLOP HOLDINGS LIMITED, *Petitioner*

v.

RAM GOLF CORPORATION, *Respondent*

PETITIONER'S REPLY TO THE "BRIEF FOR RESPONDENT IN OPPOSITION"

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February 1976

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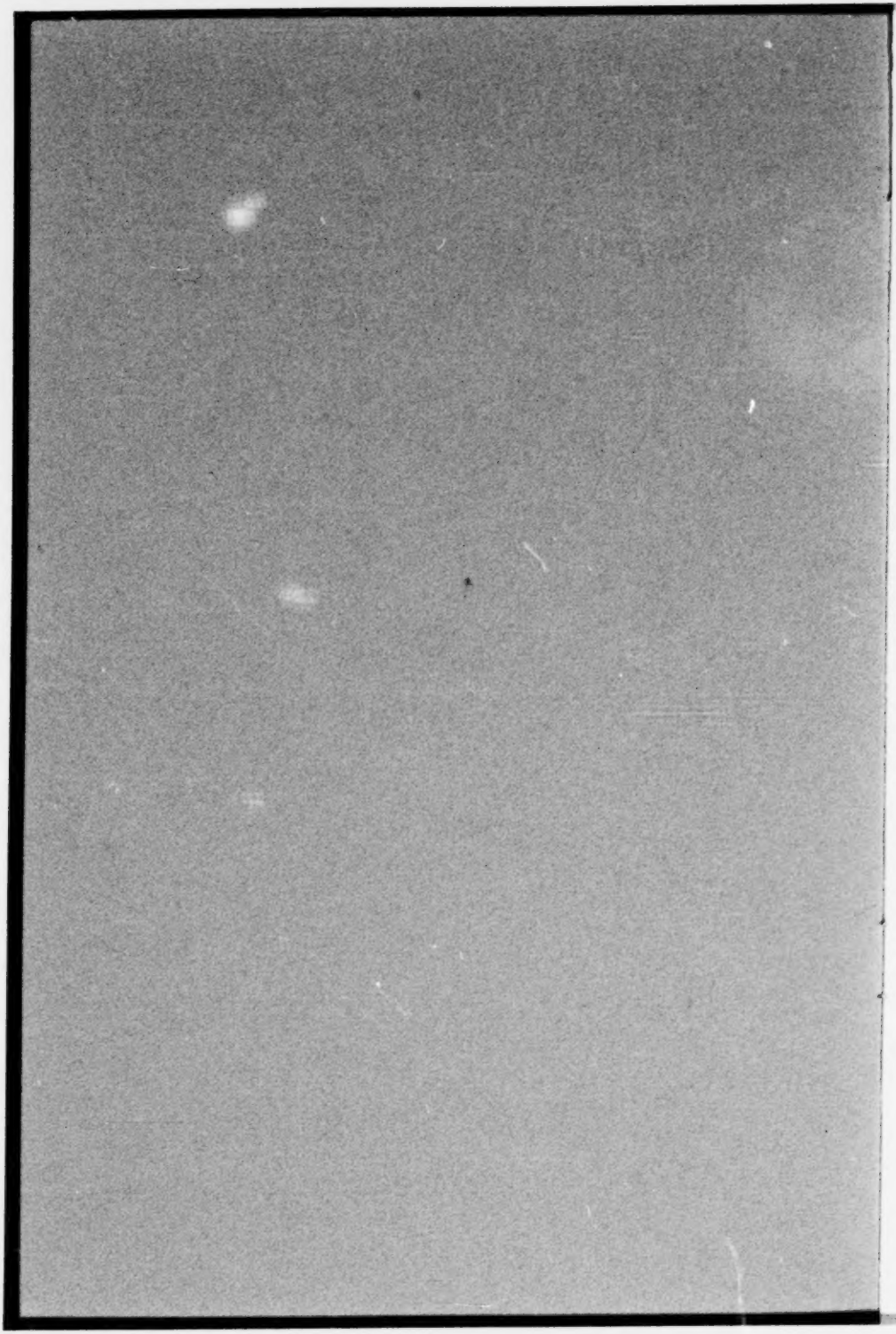

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Contrary to the suggestion appearing in the opening sentence of the Brief in Opposition of the respondent Ram Golf Corporation ("Ram"), this is definitely *not* a "routine patent case". Perhaps understandably, Ram's Brief perpetuates the same error on the point at issue here that is found in so many lower court decisions. It is for precisely this reason that the authoritative guidance of this Court is so badly needed.

The five Supreme Court cases [1] cited in Ram's Brief (p. 2) may for convenience be placed in two broad categories: a first category (1), those in which the patentee was confronted by anticipatory or allegedly anticipa-

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[1] Listed chronologically, these are: *Gayler* v. *Wilder*, 10 How. (51 U.S.) 447 (1850); *Kendall* v. *Winsor*, 21 How. (62 U.S.) 322 (1858); *Egbert* v. *Lippmann*, 104 U.S. 333 (1881); *Hall* v. *MacNeale*, 107 U.S. 90 (1882); and *Electric Storage Battery Co.* v. *Shimadzu*, 307 U.S. 5 (1939).

tory work *by a third party:* and a second category (2), those in which the patentee was confronted by his own earlier work where *it was the patentee himself* who had delayed too long before filing his patent application, thereby resulting in what is actually a "loss of right to patent"[2] by the real inventor though sheer delay on his part.

In category (1) fall the *Gayler* and *Electric Storage Battery Co.* cases cited by Ram. The *Kendall, Egbert* and *Hall* cases fall in category (2).

Since no one has ever suggested that there was the remotest connection between Butch Wagner and the inventors of the Dunlop patent in the case at bar, it is clear that category (2) cases have nothing whatsoever to do with the present case. However, the fact that category (2) cases are cited indiscriminately by Ram together with category (1) cases shows how easily the exceedingly common (but nevertheless fundamental) error referred to above has been perpetuated down through the years.

Of the two category (1) cases cited by Ram, in *Gayler* the activities of the prior worker did not really enrich the art and the patent in suit was sustained. In the second category (1) case *(Electric Storage Battery Co.)* there was no effort at concealment[3] on the part of the prior workers, and so the patent in suit was held invalid.

In the case at bar, however, there was very definitely an active concealment—and in addition an admitted failure of the results of the earlier work (because of its

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[2] To quote from the section heading of 35 U.S.C. § 102. (Pet. 4)

[3] This fact was specifically mentioned by the Court. See 307 U.S. at 20.

nature) to communicate to the public knowledge of how to reproduce the invention at will prior to the critical date of the patent.

Ram complains (Br. in Opp. 6) that petitioner "has not cited a single case which supports the opposite conclusion". There has been no such case (in this Court) presenting the unique combination of circumstances of the present case.

Inventors and prospective inventors, investors and prospective investors in technology all need the authoritative guidance of this Court in respect of the effect on a later patent, where before the critical date of the patent, some earlier work was done by another in utmost secrecy and without conferring upon the public the benefit of that earlier work in the sense of thereby making the nature of the invention known to, and therefore reproducible at will by, the public.

For this Court to refrain from providing the necessary guidance might well have the disastrous result of contributing ultimately to "driving invention underground"—a result certainly contrary to the spirit of the Patent System.

Dunlop in its petition elected not to cite *any* lower court decisions since it is a definitive ruling from *this* Court that is needed in order once and for all to settle the obviously unsettled state of the law represented by lower court decisions in this area of patent jurisprudence—see Dunlop's petition at the top of page 13. However, since Ram saw fit to cite two lower court cases in its Brief in Opposition, Dunlop considers it appropriate to point out that of those two cases, *Magnetics* is not relevant because the opinion there shows

on its face that there was no attempt at concealment on the part of the prior workers.

The second lower court case cited by Ram, *Gillman* with opinion by Judge Learned Hand, involves a *secret* prior user situation—and in fact in its actual holding in the light of the particular facts of the case, *Gillman* more nearly suggests the propriety of the same ruling (of patent validity) in the case at bar. This becomes even more apparent from Judge Hand's typically lucid gloss on *Gillman* in the later case of *Metallizing Engineering Co., Inc.* v. *Kenyon Bearing & Auto Parts Co., Inc.*, 153 F.2d 516 (2nd Cir. 1946). See especially the distinction drawn by Judge Hand[4] at p. 519, lower right column.

There is nothing "sacred" about any one of the various kinds of statutory bars enumerated in 35 U.S.C. § 102—no reason to exalt any one over any of the others. Hence neither law nor logic requires an admittedly noninforming (and in fact noninformable) prior use to be given any weightier or different effect as an alleged anticipation of a later patent than (say) a prior *publication* or a prior *patent* of another that likewise fails to disclose to the public the key secret of the later patent. And in any event, note *Tilghman* (Dunlop's petition at pp. 14-15).

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[4] Besides his universally recognized judicial talents in general law, the late Judge Hand was regarded as an outstanding jurist in the field of patent law. See e.g., 38 J.Pat.Off.Soc. 441 (June, 1956).

The Court should grant certiorari to dispel the serious uncertainties attendant upon situations like that represented by the case at bar.

Respectfully submitted,

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